

REMARKS/ARGUMENTS

Claims 6-12 are pending in the present application after this amendment adds claims 11 and 12. The Title has been amended in response to the Examiner's objection. In addition, claim 6 has been amended. The amendments do not add new matter and find support throughout the Specification and Figures.

35 U.S.C. § 103(a)

Claims 6-10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.K. Patent No. 1,190,459 issued to General Dynamics Corporation ("the GDC reference") in view of United States Patent No. 4,888,815 to Ahlemeyer et al. ("the Ahlemeyer reference") and in view of United States Patent No. 4,115,737 to Hongu et al. ("the Hongu reference"). Applicants respectfully submit that claims 6-10 are in condition for allowance for at least the following reasons.

In order for a claim to be rejected for obviousness under 35 U.S.C. § 103(a), not only must the prior art **teach or suggest each element of the claim**, but the prior art must also **suggest combining the elements in the manner contemplated by the claim**. See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990). The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. M.P.E.P. §2142. To establish a *prima facie* case of obviousness, the Examiner must show, *inter alia*, that there is some **suggestion or motivation**, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, **to modify or combine the references** and that, when so modified or combined, the prior art **teaches or suggests all of the claim limitations**. M.P.E.P. §2143. Applicants respectfully submit that these criteria for obviousness are not met here.

Amended independent claim 6 relates to a radio receiver device and recites, among other things, a mixing oscillator for converting a received high-frequency signal into a defined intermediate frequency. In accordance with an operation of the changeover device, the mixing

oscillator of claim 6 is able to be changed over in a tuning range to one of the first variably tunable tuning stage and the second variably tunable tuning stage in such a way that for the first receiving range of the first variably tunable tuning stage an **oscillation frequency of the first variably tunable tuning stage is set above a frequency to be received by a quantity of the defined intermediate frequency**, and that for the second receiving range of the second variably tunable tuning unit an **oscillation frequency of the second variably tunable tuning stage is set below the frequency to be received by the quantity of the defined intermediate frequency**.

The Office Action asserts that the GDC reference indicates that an oscillation frequency of the first variably tunable tuning stage is capable of being set above a frequency to be received by a quantity of the defined intermediate frequency, and that an oscillation frequency of the second variably tunable tuning stage is capable of being set below the frequency to be received by the quantity of the defined intermediate frequency. Specifically, the Office Action indicates that the “changeover switch selected VFO band A (54) and VFO band B (56) would be designed to mix for a fixed IF output.” (Office Action, page 3, ll. 17-18, citing the GDC reference, p. 5, l. 117 - p. 6, l. 36). However, the cited sections of the GDC reference do not discuss, or even suggest, that an oscillation frequency of the first variably tunable tuning stage is set above a frequency to be received by a quantity of the defined intermediate frequency, and that an oscillation frequency of the second variably tunable tuning stage is set below the frequency to be received by the quantity of the defined intermediate frequency. Applicants respectfully request the Examiner to provide specific support for the assertion that the GDC reference discloses an oscillation frequency being set above a received frequency in one band by a defined amount, and set below a received frequency in another band by the same amount.

To the extent that the Examiner is relying on the doctrine of inherency, i.e., the GDC reference inherently teaches the claimed limitations, Applicants note that the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flows from the teachings of the applied art.”

(See M.P.E.P. § 2112; emphasis in original; and *see, Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic *may occur* in the prior art does not establish the inherency of that result or characteristic. Clearly, the explicit teachings of the GDC reference in no way **necessarily lead** to the claimed limitations.

The addition of the Ahlemeyer reference and the Hongu reference fails to cure this critical deficiency of the GDC reference as applied against claim 6. Though the Ahlemeyer reference apparently discusses a single mixing oscillator, there is no indication that the mixing oscillator has the features recited in claim 6. In particular, the cited sections of the Ahlemeyer reference do not disclose, or even suggest, that an oscillation frequency of the first variably tunable tuning stage is set above a frequency to be received by a quantity of the defined intermediate frequency, and that an oscillation frequency of the second variably tunable tuning stage is set below the frequency to be received by the quantity of the defined intermediate frequency. The Hongu reference is cited by the Examiner for merely teaching “a receiving antenna connected to a first and second tuned stage of a multiband tuner, but with switched band selection prior to the first stage.” The Hongu reference clearly does not disclose or suggest that an oscillation frequency of the first variably tunable tuning stage is set above a frequency to be received by a quantity of the defined intermediate frequency, and that an oscillation frequency of the second variably tunable tuning stage is set below the frequency to be received by the quantity of the defined intermediate frequency. Since the applied references do not disclose or suggest the features of claim 6, the combination of the applied references cannot render obvious the subject matter of claim 6. Claims 7-10 depend from claim 6 and are therefore allowable for at least the same reasons that claim 6 is allowable.

For at least the reasons discussed above, withdrawal of the rejection under 35 U.S.C. §103(a) with respect to claims 6-10 is hereby respectfully requested.

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New Claims

New claims 11 and 12 depend from claim 6 and are allowable for at least the same reasons that claim 6 is allowable.

Independent of the above, claim 11 recites at least one further variably tunable tuning stage for a further receiving range, the at least one further variably tunable tuning stage being capable of being switched separately from the first variably tunable tuning stage and the second variably tunable tuning stage. It is respectfully submitted that none of the cited references discloses, or even suggests, this feature, and therefore new claim 11 is allowable over the cited references.

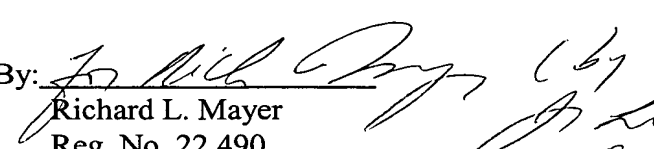
Independent of the above, claim 12 recites that the defined intermediate frequency is about 10.7 MHz. It is respectfully submitted that none of the cited references discloses, or even suggests, this feature, and therefore new claim 12 is allowable over the cited references.

CONCLUSION

Applicants respectfully submit that all of the pending claims of the present application are now in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

Respectfully submitted,

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